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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,189	01/26/2004	David Bieber	01876.0039	6440
22852 7590 09/11/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SILBERMANN, JOANNE	
			ART UNIT 3611	PAPER NUMBER
			MAIL DATE 09/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/763,189	<b>Applicant(s)</b> BIEBER, DAVID	
	<b>Examiner</b> Joanne Silbermann	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,14,18-21,27,35,37,39-41,45,52-54,56,58,73,76,77 and 79-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 2-4,9-13,15-17,22-26,28-34,36,38,42-44,46-51,55,57,59-72,74,75 and 78.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 2-4, 9-13, 15-17, 22-26, 28-34, 36, 38, 42-44, 46-51, 55, 57, 59-72, 74, 75 and 78 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 2, 2006.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 depends from claim 1, yet recites another article of merchandise. It is not clear if this is the same article, or if another is intended to be claimed.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 14, 27, 37, 45, 54, 73 and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Tourigny, US #5,170,917.

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6. Tourigny discloses a display sleeve including top and bottom open ends 18 (Figure 2), a substantially flat front side having window 32 and border 22, substantially flat back side 10, an advertising sheet retained in pocket 16 (column 2 lines 50-57) having information thereon and which may be removed and exchanged. An article of merchandise (the sleeve of the wearer's jacket) is inserted through the open ends of the display sleeve.
7. Regarding claim 14, Tourigny discloses first and second sides 18 with a connection therebetween for the article of merchandise to be inserted therein. The advertising sheet is provided and the holder is configured for exchanging the sheet.
8. Regarding claim 45, the article of manufacture extends along a direction parallel to the longitudinal axis of the sleeve and the advertising sheet is visible through the front side.
9. Regarding claim 54, the holder is removably attached around the article of merchandise.
10. Regarding claim 73, the holder is bowed (Figure 1) for insertion and removal of the sheet.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 5-8, 18-21, 35, 39-41, 52, 53, 56, 58 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tourigny in view of Kaiser, US #5,254,026.

13. Tourigny does not teach a transparent sleeve around the sheet and between the front and back sides of the display sleeve. Kaiser teaches a display sleeve 130, 132 with advertising sheet 250 held therebetween (Figures 1 and 2). Transparent sleeve 120 (Figure 1) holds the advertising sheet for viewing through window 170. It would have been obvious to a person having ordinary skill in the art to utilize a clear sleeve in the holder to provide protection for the advertising sheet, as is taught by Kaiser.

14. Tourigny and Kaiser do not specifically teach the size of the sheet held by the display holder, however it would have been obvious to one of ordinary skill to utilize a holder larger enough for a desired display sheet. Tourigny teaches folding up the sheet so that a larger sheet may be retained without disturbing the wearer.

15. Regarding claims 8 and 21, Kaiser teaches the clear sleeve as having open end 128 and three sealed edges (column 5 lines 1-4) and is attached to the display holder at edge 124.

16. Regarding claim 58, the transparent sleeve, when inserted into the display sleeve, is configured to wrap around the article of merchandise.

17. Claims 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toruigny in view of Sadow, US #6,151,818.

18. Tourigny, as described above, also teaches connector tabs 28 and 29 extending between the first and second sides (Figure 2) along a direction parallel to the longitudinal axis. Tourigny does not teach attaching the holder to an article having a

trolley handle, however Sadow teaches that it is well known in the art to apply information holders to such handles. It would have been obvious to one of ordinary skill in the art to utilize a holder as in Tourigny on the handle of Sadow so as to provide a holder that will protect the information sheet.

19. Claims 82 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tourigny and Sadow, as applied to claim 81 above, and further in view of Kaiser.

20. Tourigny and Sadow do not teach a transparent sleeve in the holder, however this is shown by Kaiser, as described above. It would have been obvious to one of ordinary skill in the art to utilize such a transparent sleeve to provide additional protection for the display, as is taught by Kaiser.

### ***Response to Arguments***

21. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The new rejection has been made in response to Applicant's amendments to the claims, particularly requiring top and bottom ends and the article of merchandise extending through the ends and the article of merchandise including a trolley handle.

### ***Conclusion***

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Joanne Silberman  
Primary Examiner  
Art Unit 3611

js

04 September 2007